



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,163	01/24/2004	Amanda K. Bridges	2003-0667.02	8163
21972	7590	02/05/2008	EXAMINER	
LEXMARK INTERNATIONAL, INC.			CHEEMA, UMAR	
INTELLECTUAL PROPERTY LAW DEPARTMENT			ART UNIT	PAPER NUMBER
740 WEST NEW CIRCLE ROAD			2144	
BLDG. 082-1				
LEXINGTON, KY 40550-0999				
MAIL DATE		DELIVERY MODE		
02/05/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/764,163	BRIDGES ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Umar Cheema	2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 13 November 2007.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-33 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-33 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 24 January 2004 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. \_\_\_\_.  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_.

## DETAILED ACTION

### ***Response to Amendment***

1. This action is in response to Amendment filed on 13 November 2007. Claims 1-33 are pending in which claims 1, 16, 24, and 32 are independent claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsushima (US Patent # 7,019,860) in view of Bahar (US 2002/0019852).

Regarding claim 1, Matsushima substantially discloses the invention as claimed a method of using a print device, comprising the steps of: carrying out a specified task at

a print device (see col. 1, lines 61-67, col. 2, lines 1-2, printer engine); and generating an email confirmation including an indication of success or failure of said carried out task at said print device (see col. 7, lines 26-34, col. 8, lines 46-54, Fig 11 to Fig 13).

Matsushima does not explicitly disclose wherein said generating an email confirmation. However in the same field of invention Bahar discloses wherein said generating an email confirmation (see par. 0013, 0034, 0038; providing notice of the email and generating the confirmation of receipt notice).

It would have been obvious to one of the ordinary skill in the art of networking at the time of this invention to combine the teaching of Matsushima and Bahar for email confirmation for specific task at print device. Motivation for doing so would have been advantageous to actively determine the identity of the recipient individual actually receiving and/or given notice of the email, as well as other actively discovered information indicative of proper delivery which is found on the recipient computer system of the recipient individual (see Bahar: par. 0008).

Regarding claim 2, Matsushima discloses the method of claim 1, wherein said step of carrying out a specified task includes rendering image data at said print device (see col. 2, lines 3-18; image formation).

Regarding claim 3, Matsushima discloses the method of claim 2, wherein said rendered image data corresponds to one of a scan to network job and a fax job (see col. 10, lines

51-56).

Regarding claim 4, Matsushima discloses the method of claim 1, wherein said email confirmation relates to a scan to network job (see col. 10, lines 42-48).

Regarding claim 5, Matsushima discloses the method of claim 4, wherein said email confirmation includes upon said failure at least one of a primary SMTP gateway IP address (see col. 1, lines 27-33); a connection failure, and number of connection tries; and a mail server response (see col. 7, lines 26-34, col. 11, lines 8-23).

Regarding claim 6, Matsushima discloses the method of claim 1, wherein said email confirmation relates to a fax job (see col. 10, lines 51-56).

Regarding claim 7, Matsushima discloses the method of claim 6, wherein said email confirmation includes upon said failure at least one of a connection failure, and number of connection tries; date; station name; and station number (see col. 7, lines 13-19).

Regarding claim 8, Matsushima discloses the method of claim 2, wherein said email confirmation includes a thumbnail image associated with said rendered image data upon a successful rendering of said image data, and said email confirmation does not include a thumbnail image associated with said rendered image data upon an unsuccessful rendering of said image data (see col. 7, lines 26-34, col. 8, lines 46-54,

Fig 11 to Fig 13).

Regarding claim 9, Matsushima discloses the method of claim 2, wherein said email confirmation includes an attachment (see col. 7, lines 50-57).

Regarding claim 10, Matsushima discloses the method of claim 9, wherein said email confirmation includes a thumbnail image of said attachment (see col. 7, lines 50-57).

Regarding claim 11, Matsushima discloses the method of claim 9, wherein said email confirmation includes a thumbnail image of said attachment upon a successful rendering of said image data, and said email confirmation does not include a thumbnail image of said attachment upon an unsuccessful rendering of said image data (see col. 7, lines 26-34, col. 8, lines 46-54, Fig 11 to Fig 13 lines 50-57).

Regarding claim 12, Matsushima discloses the method of claim 9, wherein said email confirmation comprises information relating to said attachment, including at least one of a file name, data format, and rendered image resolution (see col. 7, lines 26-34).

Regarding claim 13, Matsushima discloses the method of claim 1, wherein said generating step includes the substep of transmitting said email confirmation over a network (see col. 4, lines 57-63).

Regarding claim 14, Matsushima discloses the method of claim 13, wherein said transmitting step includes transmitting said email confirmation over a network using one of said print device and a computer attached to said network (see col. 7, lines 13-19, lines 50-57).

Regarding claim 15, Matsushima discloses the method of claim 1, wherein said print device is part of a multi-function machine (see col. 3, lines 35-40, fig. 1).

Regarding claim 16, Matsushima substantially discloses the invention as claimed a method of using a print device, comprising the steps of: carrying out a specified task at a print device (see col. 1, lines 61-67, col. 2, lines 1-2, printer engine); and generating an email confirmation including an indication of success or failure of said carried out task at said print device, said email confirmation including a thumbnail image associated with said specified task upon successfully carrying out said specified task, and said email confirmation not including a thumbnail image associated with said specified task upon unsuccessfully carrying out said specified task (see col. 7, lines 26-34, col. 8, lines 46-54, Fig 11 to Fig 13).

Matsushima does not explicitly disclose wherein said generating an email confirmation. However in the same field of invention Bahar discloses wherein said generating an email confirmation (see par. 0013, 0034, 0038; providing notice of the email and generating the confirmation of receipt notice).

It would have been obvious to one of the ordinary skill in the art of networking at the time of this invention to combine the teaching of Matsushima and Bahar for email confirmation for specific task at print device. Motivation for doing so would have been advantageous to actively determine the identity of the recipient individual actually receiving and/or given notice of the email, as well as other actively discovered information indicative of proper delivery which is found on the recipient computer system of the recipient individual (see Bahar: par. 0008).

Regarding claim 17, the limitations of this claim has already been addressed (see claim 2 above).

Regarding claim 18, the limitations of this claim has already been addressed (see claim 3 above).

Regarding claim 19, the limitations of this claim has already been addressed (see claim 8 above).

Regarding claim 20, the limitations of this claim has already been addressed (see claim 9 above).

Regarding claim 21, the limitations of this claim has already been addressed (see claim 13 above).

Regarding claim 22, the limitations of this claim has already been addressed (see claim 14 above).

Regarding claim 23, the limitations of this claim has already been addressed (see claim 15 above).

Regarding claim 24, Matsushima substantially discloses the invention as claimed a method of using a print device, comprising the steps of: carrying out a Specified task at a print device (see col. 1, lines 61-67, col. 2, lines 1-2, printer engine); and generating an email confirmation at said print device, said email confirmation including information pertaining to said specified task (see col. 7, lines 26-34, col. 8, lines 46-54, Fig 11 to Fig 13).

Matsushima does not explicitly disclose wherein said generating an email confirmation. However in the same field of invention Bahar discloses wherein said generating an email confirmation (see par. 0013, 0034, 0038; providing notice of the email and generating the confirmation of receipt notice).

It would have been obvious to one of the ordinary skill in the art of networking at the time of this invention to combine the teaching of Matsushima and Bahar for email confirmation for specific task at print device. Motivation for doing so would have been advantageous to actively determine the identity of the recipient individual actually receiving and/or given notice of the email, as well as other actively discovered

information indicative of proper delivery which is found on the recipient computer system of the recipient individual (see Bahar: par. 0008).

Regarding claim 25, the limitations of this claim has already been addressed (see claim 1 above).

Regarding claim 26, the limitations of this claim has already been addressed (see claim 2 above).

Regarding claim 27, the limitations of this claim has already been addressed (see claim 3 above).

Regarding claim 28, the limitations of this claim has already been addressed (see claim 8 above).

Regarding claim 29, the limitations of this claim has already been addressed (see claim 13 above).

Regarding claim 30, the limitations of this claim has already been addressed (see claim 14 above).

Regarding claim 31, the limitations of this claim has already been addressed (see claim 15 above).

Regarding claim 32, Matsushima substantially discloses the invention as claimed a method of using a print device, comprising the steps of: coupling a print device and a computer to a network at different physical locations (see fig. 1); carrying out a specified task at one of said print device and said computer (see col. 1, lines 61-67, col. 2, lines 1-2, printer engine); generating a confirmation report indicating success or failure of said specified task; and providing access to said confirmation report at an other of said print device and said computer (see col. 7, lines 26-34, col. 8, lines 46-54, Fig 11 to Fig 13).

Matsushima does not explicitly disclose wherein said generating a confirmation report. However in the same field of invention Bahar discloses wherein said generating a confirmation report (see par. 0013, 0034, 0038; providing notice of the email and generating the confirmation of receipt notice).

It would have been obvious to one of the ordinary skill in the art of networking at the time of this invention to combine the teaching of Matsushima and Bahar for email confirmation for specific task at print device. Motivation for doing so would have been advantageous to actively determine the identity of the recipient individual actually receiving and/or given notice of the email, as well as other actively discovered information indicative of proper delivery which is found on the recipient computer system of the recipient individual (see Bahar: par. 0008).

Regarding claim 33, Matsushima discloses the method of claim 32, wherein said print device comprises a multifunction machine including a fax, scanner and printer; said specified task comprises one of a scan to network job using said scanner and fax job using said fax; and said confirmation report comprises an email confirmation (see col. 10, lines 42-56).

***Conclusion***

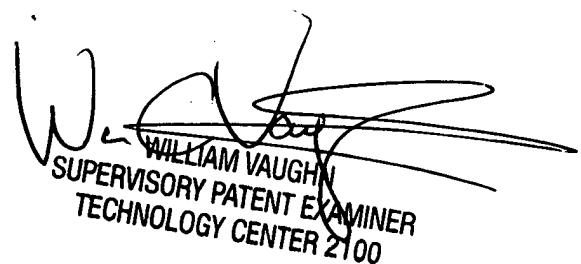
3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see form PTO-892 (Notice of Cited References) for a list of more relevant prior arts.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Umar Cheema whose telephone number is 571-270-3037. The examiner can normally be reached on M-F 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn, Jr. can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

uc



WILLIAM VAUGHN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100